

REMARKS

I. Introduction

In the Current Action:

- confirmation of the provisional election is requested;
- claims 8-14 are rejected under 35 U.S.C. § 112;
- claims 8-14 are rejected under 35 U.S.C. § 101;
- claims 8-11 and 13-14 are rejected under 35 U.S.C. § 102(b);
- claims 8 and 12 are rejected under 35 U.S.C. § 103(a).

In this response:

- claim 8 is amended;
- claims 21-29 are added; and
- arguments are presented that traverse all outstanding rejections.
- Claims 1-29 are pending.

II. Restriction Requirement

The Applicant confirms the election of claims 8-14 for continued prosecution, WITHOUT TRAVERSE.

III. Amendments and New Claims

Claim 8 has been amended to more clearly claim the invention and claims 21-29 have been added. Support for these amendments and additions can be found, among other places, at pages 3 and 5 of the specification. At page 3 material lead time is defined as time for ordering and obtaining material from manufacturers. At page 5, this and other information is reevaluated to determine, among other things, follow up orders. No new matter has been added. The Applicants respectfully submit that claims 8-14 are patentable over the rejection of record. The Applicants further submit that claims 21-29 recite subject matter that is patentable over the art cited.

IV. Rejections Under 35 U.S.C. § 112

Claims 8-14 stand rejected as being indefinite. Specifically, claim 8 (the Applicant has assumed this rejection is directed to claim 8, rather than claim 1 as the Current Action appears to indicate) is deemed indefinite for: 1) reciting “electronically;” 2) not indicating who (or what) determines the required quantity, and 3) not stating a specific origination point and destination point of the communication. However, each of the items indicated by the Examiner are recitations that the Applicant has intentionally made broad. Claim 8 covers electronic determinations made by a computer as well as those made by any other device or system within the scope of the claim. Claim 8 also covers quantity determinations made by a supplier, a user, or anything else within the scope of the claim. Claim 8 further covers communications that are, intentionally, not limited to any one specific origination or destination point. The Applicant respectfully reminds the Examiner that breadth is not indefiniteness, see M.P.E.P. § 2173.04, and that while the specifics of the limitations may be left unrestricted, the scope of the subject matter embraced by claim 8 is quite clear. Because this clarity is all that the M.P.E.P. requires, the Applicant respectfully asks the Examiner to withdraw the 35 U.S.C. § 112 rejection of claim 8.

Claim 14 is also rejected as indefinite. According to the Current Action, “compare is normally read to mean two entities, but this claim shows four.” However, the Applicant respectfully submits that this represents a misreading of claim 14. Claim 14 includes comparing “an actual run rate to a corresponding anticipated run rate,” and comparing “an actual production yield to an anticipated production yield.” The Applicant believes that the language of claim 14 clearly articulates the entities being compared, and respectfully ask the Examiner to withdraw the rejection.

V. Rejections Under 35 U.S.C. § 101

The Current Action rejects claims 8-14 as directed to unpatentable subject matter. The Examiner supports this contention by implying that no invention is patentable if it is “accomplished purely by human intervention.” The Applicant respectfully submits that no such prohibition exists. If the Examiner is basing this rejection upon uncited authority, the Applicant respectfully asks the Examiner to supply a citation and allow the Applicant a reasonable opportunity to respond.

The Examiner further implies that no claim is allowable without a “recited utilization of any technical art,” but cites no authority other than 35 U.S.C. § 101. The Applicant respectfully points out that the wording of 35 U.S.C. § 101 contains no “recited utilization of any technical art” requirement. The Applicant further points out that 35 U.S.C. § 101 explicitly permits patents to “whosoever invents any new or useful process,” and the Applicant respectfully asserts that the recitations of claims 8-14 clearly meet this definition.

In light of the above, the Applicant respectfully submits that claims 8-14 are directed to statutory subject matter and respectfully ask the Examiner to withdraw the rejection.

VI. Rejections Under 35 U.S.C. § 102(b)

Claims 8-11 and 13-14 are rejected by the Current Action as anticipated by *Graves, et al.*, United States Invention Registration No. H1743 (hereinafter *Graves*). To be anticipatory, M.P.E.P. § 2131 requires that a reference teach each and every element of a rejected claim. Claim 8, as amended, recites “using feedback relating to performance of at least one supply chain participant.” The Applicant respectfully submits that *Graves* does not teach this limitation. The Current Action cites column 17 lines 28-47 of *Graves* as teaching “a feedback process used to re-calculate the needed amount of re-supply.” However, the cited feature of *Graves* merely monitors the level of a storage tank and compares it to projected levels, and such a comparison would provide no information regarding the performance of a supply chain participant. Therefore, the Applicant respectfully submits that claim 8 is patentable, and asks the Examiner to withdraw the rejection.

Claims 9-11 and 13-14 depend either directly or indirectly from claim 8. Although each of claims 9-11 and 13-14 recite limitations that render them patentable in their own right, claims 9-11 and 13-14 are at least patentable because claim 8 is. Therefore, the Applicant respectfully asks the Examiner to withdraw the rejections of claims 9-11 and 13-14 as well.

In addition, claim 14 specifically recites “using feedback that compares an actual run rate to a corresponding anticipated run rate and an actual production yield to an anticipated production yield.” The Current Action has rejected claim 14 by opining that *Graves* teaches a feedback process “which involves a comparison between actual and theoretical.” Without

conceding this point, the Applicant notes that “a comparison between actual and theoretical” is not the limitation of claim 14. Claim 14 recites “using feedback that compares an actual run rate to a corresponding anticipated run rate and an actual production yield to an anticipated production yield,” which *Graves* does not teach. *Graves* does not, therefore, teach every limitation of claim 14 and the Applicant asks the Examiner to withdraw the rejection.

VII. Rejections Under 35 U.S.C. § 103(a)

Claims 8 and 12 have been rejected as obvious in light of *Graves*. The Applicant believes the addition of claim 8 in this rejection was inadvertent, and that the Examiner meant to reject only claim 12 as obvious in light of *Graves*. Regardless of which claims the Examiner intends to reject, however, the rejection made by the Current Action does not meet the requirements for an obviousness rejection.

The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in Graham v. John Deere and Co., 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art, and (4) evaluate evidence of secondary considerations. See M.P.E.P. § 2141.

The M.P.E.P. § 706.02(j), incorporates the mandate of Graham v. John Deere and directs the Examiner to set forth in the Office action: (1) the relevant teachings of the prior art relied upon; (2) the difference or differences in the claim over the applied references; (3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The Current Action, however, fails to set forth this analysis. The Current Action’s rejection of claim 12 is the mere statement that “Graves et al discloses communicating to notify supplier of an order and reminder is deemed to be a mere repetition of that initial step.”

This statement provides no motivation for modifying *Graves* as the Examiner proposes, and the Applicant respectfully points out that a repetition of an order (the initial step of *Graves*) would be a reorder, not a reminder. Both case law and the M.P.E.P. require the Examiner propose a modification that arrives at the claimed subject matter, and provide a complete explanation of why one of ordinary skill in the art would make such a modification in order to make a proper. The Current Action has failed to set forth this analysis, and the Applicant respectfully asks the Examiner to withdraw the rejection.

VIII. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes that a fee of \$334.00 is due with this response. However, if any additional fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004991-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482735483US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: May 13, 2004

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